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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/555,093	08/22/2000	Johnathan A. Napier	00487.00001	1868

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EXAMINER
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MCELWAIN, ELIZABETH F

ART UNIT	PAPER NUMBER
1638	12

DATE MAILED: 06/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/555,093

Applicant(s)

NAPIER, JOHNATHAN A.

Examiner

Elizabeth McElwain

Art Unit

1638

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-38 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

The Preliminary Amendments filed August 22, 2000 and February 19, 2002 have been entered.

Claims 1-38 are pending.

Please note that claim 25 has improper antecedent basis for a "metabolite" in claim 23.

5 Correction of the claim dependency is required.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13 and 23, drawn to a polypeptide having desaturase activity,  
classified in class 530, subclass 370, for example.
- 10 II. Claim 14, drawn to a polypeptide having desaturase activity linked to another  
moiety, classified in class 530, subclass 350, for example.
- III. Claims 15, 18 and 19-22, drawn to use of a polypeptide to raise antibodies and  
to antibodies, classified in class 530, subclass 387.1, for example.
- IV. Claims 16 and 17, drawn to use of a polypeptide as a marker for transformation,  
15 classified in class 435, subclass 4, for example.
- V. Claims 24-26, drawn to use of a polypeptide having desaturase activity to  
prepare medicament for treating a disorder, classified in class 514, subclass 2,  
for example.
- VI. Claim 27, drawn to a method of making GLA, classified in class 424, subclass  
20 94.1, for example.

VII. Claim 28, drawn to a method of making OTA, classified in class 424, subclass 94.1, for example.

VIII. Claim 29-33 and 36-38, drawn to a nucleic acid encoding a desaturase, a vector and a host, classified in class 435, subclass 419, for example.

5 IX. Claim 34, drawn to a method of obtaining a polypeptide, classified in class 435, subclass 69.1, for example.

X. Claim 35, drawn to the use of a nucleic acid as a probe or primer, classified in class 435, subclass 72, for example.

10 The inventions are distinct, each from the other because:

The inventions of Groups III-VII and IX-X are distinct methods given that each method requires different method steps and different components, and each results in the production and isolation of chemically and structurally distinct products. In addition, the products of Groups I, II and VIII are chemically and structurally distinct, which are not required one by  
15 the other. In addition, the methods of Groups III-VII and IX-X are not required for the production of the claimed products of Groups I, II and VII, as each product can be made by an alternative method using different starting materials and different method steps, and one is not required by the other. Thus the inventions of Groups I-X are each capable of being separately made, independently used and the patentability of one would not render the other obvious or  
20 unpatentable.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, their recognized divergent subject matter, and the requirement for different areas of search, restriction for examination purposes as indicated is proper.

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth F. McElwain whose telephone number is (703) 308-1794. The examiner can normally be reached on Monday through Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at (703) 306-3218. The fax phone number for this Group is (703) 308-4242. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989).

Any inquiry of a general nature or relating to the status of this application should be directed to the legal analyst, Gwendolyn Payne, whose telephone number is (703) 305-2475, or to the Group receptionist whose telephone number is (703) 308-0196.

ELIZABETH F. McELWAIN  
PRIMARY EXAMINER  
GROUP 1800

*E. F. McElwain*